

## **Remarks**

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

The singular issue of record is the rejection of all of the original claims of record "under 35 U.S.C. 103(a) as being unpatentable over Dawlr (GB2248160) in view of Daijogo et al 95,936,696) [sic] and further in view of Lang et al (6,476,358) and Mischel" (5,408,069).

The Examiner correctly states "Dawlr discloses a mirror." Absent from the latter brief phrase is the fact that the "mirror" of the Dawlr invention is a "heatable mirror" which "facilitates electrical connection to the supply mains in good safety conditions given that the two supply wires may be connected in the same zone since the connection ends of the two leads are in the immediate vicinity of one another facilitating connection via a single power cord with double electrical insulation." (See page 2, lines 21-26) Because of the presence of electrically insulating material, it is thereby possible "to form an electric heating circuit having a heating surface which is as large as possible with respect to the surface of the laminate and having a double electrical insulation." (See column 2, lines 28-32.) The specifics of the mirrors shown in Figures 1 through 4 is described beginning at page 9, line 22, and the Examiner's description fairly parallels the same except for the utilization of interesting terminology on the part of the Examiner, such as calling the "two collectors 8 and 9" (page 9, line 31) "integrated electrical means 8, 9." No matter the terminology, the disclosure as a whole, including the electrically conductive heating coating 7 and the current collectors 8, 9, is to provide "heatable mirrors for bathrooms which give off a

slight heat to eliminate the mist which forms on the front surface of the mirror.” (See page 1, lines 12-15.) The latter certainly evidences “the scope and content of the prior art” patent to Dawlr. (See Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).)

Totally absent in the “scope and content” of the Dawlr patent is a laminated glass mirror which includes integrated cable-free illuminating means and/or switching means and/or sensing means due to the specific construction recited in the specification beginning at page 3, line 20 and continuing through page 4, line 28. More importantly, the latter specific disclosure is also reflected in independent claim 13 which lacks correspondence to the primarily applied patent to Dawlr.

As evidence of the latter, though the Examiner clearly mentioned the Dawlr elements 2 through 9, left unmentioned were the specific structure recited in original and now cancelled claim 1 and included in new claim 13. As one example, claim 1 and claim 13 not only recited electrical means (6) but in claim 1 called for the same as being “mounted on an electrically conducting coating (14) of the second glass plate (10) in portions opposite the transparent and/or half-reflecting portions (8) of the first glass plate (4).” The latter structural elements and the relationships thereof one to another find no counterpart in the primarily applied patent to Dawlr.

Similarly, the last limitation of claim 1 recited “ the electrically conducting coating (14) is divided into a plurality of conductor paths (16) which are separated from each other by isolation paths (18).” Once again, the latter structure finds no counterpart in the Dawlr patent and is unmentioned by the Examiner in the discussion thereof.

Quite simply, a primary patent which lacks significant limitations cannot obviously suggest to a person skilled in the art that which is not disclosed therein, particularly when it is clearly Applicant's disclosure which the Examiner is utilizing in essentially reconstructing the Dawlr heated mirror by the hindsight selection of secondary structures of three totally unrelated secondary patents. In other words, absent some suggestion for modifying the patent to Dawlr, it can only be deemed obvious that the Examiner has proceeded through hindsight in utilizing the secondary patents as was done toward the bottom of the second paragraph of the second page of the Office Action. This reason alone renders the obviousness rejection improper, and based thereupon the withdrawal thereof is in order and independent claim 13 and the claims depending therefrom are urged to be allowable.

The undersigned will, of course, comment upon the secondarily applied patents, beginning with the Examiner's comment that "Daijogo discloses a mirror with a transparent adhesive layer 57." Certainly, no one can deny that adhesive layers can be transparent. However, Figure 1 discloses a space 7 between a heater 50 formed of an electrically conducting film 51 on the surface of a transparent substrate 53 through which converging light rays pass and continue through a liquid crystal light valve 6 defined by a liquid crystal layer 61 between transparent substrate 62 and 64. Neither the heater 50 nor the crystal light valve 6 is a "mirror," as the Examiner stated. In Figure 11, the same heater 50 and liquid crystal light valve 60 are bonded to each other by a transparent adhesive layer 57, just as the Examiner has stated, but the latter does not magically transform any of the elements 6, 50 singularly or combined into a "mirror." A person skilled in the art would

certainly not look to a “projection type display apparatus including a heater for heating the liquid crystal light valve” (Abstract), particularly when there is no suggestion for doing so, either in the Dawlr patent or otherwise. The very selection of the Daijogo et al. patent by the Examiner reflects total hindsight reconstruction of the prior art.

The Examiner then states: “Lang discloses a mirror 2 having a reflective surface 10 with a partially reflective portion of the plate 10 with an aperture 58 and illumination means – a diode 42 (col. 4, lines 5-40 and Fig. 1).” The latter is another example of hindsight selection and application of prior art beginning with the fact that the Lang et al. mirror lacks two transparent glass plates and instead discloses a subassembly 26 on the back side of a support plate 22. The subassembly can be mounted on a circuit board with the LED or diode 42 secured in a holder or housing 46. (See column 4, line 12 and column 5, second paragraph.)

The diode 42 is completely outside the assembly which admittedly includes a mirror pane 8 and the various intermediate layers 10, 12, 14, 16, 18, 20, and the latter-noted support plate 22, none of which involve an arrangement between **two** glass plates of a mirror. Also interesting, though unmentioned by the Examiner, is the fact that the LED/diode of Lange et al. is activated by a thermostat upon activating the heating element, as is typical in vehicle rearview mirrors, as that taught by Lange et al.

The Court of Appeals for the Federal Circuit in Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1602, quoted the “basic factual inquiries” from the Graham, supra decision and went on to state:

No effective, uniform, reliable patent system could long survive if the law permitted a decisional approach to §103 determinations like that here employed by the district court and suggested in

Dennison's Petition for Certiorari: (1) interpreting claims by redrafting them to one word; (2) implying that that word describes the 'differences'; (3) picking from a prior patent an item describable by that word (in effect finding *no* differences); (4) focusing on isolated minutia in a prior art patent while disregarding its scope, i.e., its entire disclosure, and how its disclosed structure works.

The Examiner has first improperly interpreted claim 1 and, if not implying that the prior art included comparable structure, picked therefrom isolated minutia "while disregarding its scope, i.e., its entire disclosure, and how its disclosed structure works." The Examiner has done so with respect to both the Daijogo et al. and Lang et al. patents. With due respect, the application of the prior art as set forth in the Office Action at page 2, paragraph 2, is in error, should be withdrawn and is urged not to be applicable to similarly limited independent claim 13 and the claims depending therefrom.

Turning specifically to independent claim 13, the claim corresponds to now cancelled claim 1, but more specifically recites the various elements of Applicant's mirror, including those earlier quoted and not found in any combination of the prior art of record, particularly the limitations reading – "the first glass plate (4) being bonded to a second glass plate (10)... being divided into a plurality of conductor paths (16) which are separated from each other by isolation paths (18)." Interesting enough, nowhere has the Examiner mentioned in the rejection of record an electrically conducting coating **divided into a plurality of conductor paths** which are **separated** from each other **by isolation paths**, limitations appearing in original claim 1 and new independent claim 13.

Claim 13 has also been additionally limited by calling for "the electrical means (6) being at least partially embedded in the transparent adhesive

layer (12).” The latter limitation, in the context of the entirety of claim 13, finds no counterpart in the prior art. Simply stated, the scope and content of claim 13 is directed to unobvious subject matter, and based thereupon the formal allowance of claim 13 and each of the claims depending directly or indirectly therefrom is believed to be in order and is herewith respectfully requested.

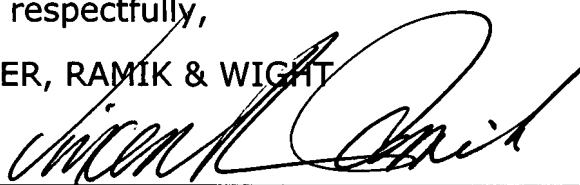
The undersigned has made a bonafide effort to place this application in condition for allowance. Should the Examiner, upon consideration of this Amendment, decide to do anything other than allow the application and all the claims appearing herein, he is requested to telephone the undersigned in order that a personal interview can be conducted with the Examiner. The undersigned will make every effort to accommodate the Examiner’s scheduling.

Absent a telephone call with respect to setting-up such an interview, the formal allowance of this application at an early date is herewith respectfully requested.

Very respectfully,

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